

Applicants : Ann Marie Schmidt, et al.  
U.S. Serial No: 10/665,867  
Filed : September 19, 2003  
Page 3

#### **REMARKS**

Claim 17 is pending in the subject application. Applicants have not added or canceled any claims. Applicants have amended claim 2 in order to more specifically point out that which applicants regard as the invention. Support for amended claim 2 can be found in the specification at, *inter alia*, page 52, lines 16 and 17 and Table 1 on page 41. Applicants maintain that this Amendment raises no issue of new matter. Accordingly, upon entry of this Amendment, claim 17 will be pending and under examination.

#### **The Claimed Invention**

This invention provides an isolated antibody immunoreactive with an epitope comprising a unique sequence present within the EN-RAGE molecule having the amino acid sequence set forth in SEQ. ID. NO:2.

#### **Rejection under 35 U.S.C. §101**

The Examiner rejected claim 17 under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. Specifically, the Examiner alleges that claim 17, directed to "an antibody", can refer to an antibody still in a living being.

In response, and without conceding the correctness of the Examiner's rejection, applicants note that claim 17, as amended, recites, in part, an *isolated* antibody. Accordingly, applicants maintain that claim 17 is not directed to non-statutory subject matter.

Applicants : Ann Marie Schmidt, et al.  
U.S. Serial No: 10/665,867  
Filed : September 19, 2003  
Page 4

**Rejection under 35 U.S.C. §112, First Paragraph**

The Examiner also rejected claim 17 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

Specifically, the Examiner alleges that the specification and claim do not set forth the structure of the multitude of potential epitopes encompassed by the claim.

In response, and without conceding the correctness of the Examiners' rejection, applicants again note that claim 17, as amended, provides an isolated antibody immunoreactive with an epitope comprising a unique sequence present within the *EN-RAGE* molecule having the amino acid sequence set forth in SEQ. ID. NO:2.

Accordingly, one skilled in the art would reasonably believe that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicants maintain that claim 17 satisfies the requirements of 35 U.S.C. §112, first paragraph.

**Rejection under 35 U.S.C. §112, Second Paragraph**

The Examiner rejected claim 17 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out the subject matter which applicants regard as the invention.

Applicants : Ann Marie Schmidt, et al.  
U.S. Serial No: 10/665,867  
Filed : September 19, 2003  
Page 5

Specifically, the Examiner alleges that applicants' interpretation of the term "unique" is not necessarily the same interpretation of others skilled in the art.

In response, and without conceding the correctness of the Examiner's rejection, applicants again note that claim 17, as amended, provides an isolated antibody immunoreactive with an epitope comprising a unique sequence present within the EN-RAGE molecule having the amino acid sequence set forth in SEQ. ID. NO:2.

Applicants maintain that the term "unique", when read in the context of claim 17, is not indefinite. Claim 17 provides an isolated antibody immunoreactive with an epitope comprising a unique sequence present within the EN-RAGE molecule having the amino acid sequence set forth in SEQ. ID. NO:2. Based on the context of the claim, one skilled in the art would understand the isolated antibody to be immunoreactive with an epitope present in SEQ. ID. NO:2 but not present in a non-EN-RAGE protein.

Accordingly, applicants maintain that claim 17 satisfies the requirements of 35 U.S.C. §112, second paragraph.

**Rejection under 35 U.S.C. §102(b)**

The Examiner further rejected claim 17 under 35 U.S.C. §102(b), as allegedly anticipated by Hitomi, et al. (European Patent Application No. EP07311166A2).

Specifically, the Examiner states that Hitomi et al. teach peptides and antibodies that comprise sequences that are 92% identical to

Applicants : Ann Marie Schmidt, et al.  
U.S. Serial No: 10/665,867  
Filed : September 19, 2003  
Page 6

applicants' SEQ. ID. NO:2, thus meeting the limitations of claim 17. Applicants understand the Examiner's assertion to be that Hitomi, et al. teach antibodies against a polypeptide having a sequence sharing 92% sequence identity with applicants' SEQ. ID. NO:2.

In response, applicants respectfully traverse.

In order for a claim to be anticipated by a cited reference, the reference must teach each and every element set forth in the rejected claim. Hitomi, et al. fail to do this.

Again, claim 17 provides an isolated antibody immunoreactive with an epitope comprising a unique sequence present within the EN-RAGE molecule having the amino acid sequence set forth in SEQ. ID. NO:2.

Applicants note that Hitomi, et al. fail to teach each and every element of claim 17, i.e. an antibody immunoreactive with an epitope comprising a *unique* sequence present within the EN-RAGE molecule having the amino acid sequence of SEQ. ID. NO:2. Hitomi, et al.'s teaching of an antibody against a polypeptide which, by the Examiner's own admission, is not an EN-RAGE does not constitute a teaching of applicants' antibody.

Accordingly, applicants maintain that claim 17 meets the requirements of 35 U.S.C. §102(b).

### Summary

For the reasons set forth hereinabove, applicants maintain that the

Applicants : Ann Marie Schmidt, et al.  
U.S. Serial No: 10/665,867  
Filed : September 19, 2003  
Page 7

claim pending is in condition for allowance, and respectfully request allowance.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

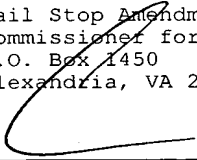
No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

  
Alan J. Morrison  
Reg. No. 37,399

Date

6/28/06

John P. White  
Registration No. 28,678  
Alan J. Morrison  
Registration No. 37,399  
Attorneys for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
Tel. No. (212) 278-0400